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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,421	12/13/2001	Mark Gilmore Mears	PU010099	9546

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EXAMINER

DESIR, JEAN WICEL

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 07/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/020,421

Applicant(s)

MEARS ET AL.

Examiner

Jean W. Désir

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/2/06, RCE.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-7, 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Karam (US 5,548,832) in view of the Background of the Invention of the instant application.

Claim 1:

The Karam's system discloses:

"a power indicator illumination", see Fig. 1 items 36, 34, col. 4 lines 1-5;

"and a user interface (see col. 3 lines 49-51, col. 5 lines 42-43), wherein the user interface is operative to allow a user to select one of first and second modes of operation, in the first mode of operation, the power indicator illumination is automatically turned on (see col. 2 lines 9-10, col. 6 lines 2-6) whenever the video apparatus is powered on, and in the second mode of operation, the power indicator illumination is turned off (see col. 4 lines 54-55, col. 5 lines 44-45) when the video apparatus is power on;

the difference between the claimed invention and Karam's system is that Karam does not explicitly say the system is for indicating the status of a video apparatus, as

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claimed. However, the Background of the Invention of the instant application describes a system that indicates the status of a video apparatus, for instance when the lamp does not work (see Background of the Invention page 1 lines 20-22); an artisan would be motivated to combine the references to arrive at the claimed invention, this combination would provide a system that would indicate information regarding the operating status of the apparatus. Therefore, the claimed invention would have been obvious to a person of ordinary skill in the art at the time the invention was made.

Claim 2 is disclosed, see Background of the Invention page 1 lines 13-22, Karam at col. 4 lines 38-39.

Claim 3 is disclosed, see Background of the Invention page 1 lines 20-22, Karam at col. 1 line 24.

Claim 4 is disclosed, see Karam at col. 3 lines 57-59.

Claim 5 is disclosed, see Karam at col. 3 lines 43-59.

Claims 6, 7 are disclosed, see Background of the Invention page 1 lines 20-22.

Claim 9 is rejected for the same reasons as claim 2.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 8 is rejected under 35 U.S.C. 102(b) as being anticipated by Karam (US 5,548,832).

Claim 8:

The Karam's system discloses:

“providing a user interface for allowing a user to select one of first and second modes of operation”, see col. 3 lines 49-51, col. 5 lines 42-43;

“receiving selection from the user”, see Fig. 1 item 26;

“if the selection indicates the first mode of operation, turning on the power indicator illumination whenever the apparatus is powered on”, see col. 2 lines 9-10, col. 6 lines 2-6;

“and if the selection indicates the second mode of operation, turning off the power indicator illumination, when the apparatus is powered on”, see col. 4 lines 54-55, col. 5 lines 44-45.

Response to Arguments

5. Applicant's arguments have been fully considered but they are not persuasive.

Applicants argue on pages 6-8 of the REMARKS that -the backlight (the alleged “power indicator illumination”) is not automatically turned on whenever the radio (the alleged “video apparatus”) is powered on, as claimed, because the backlight of Karam turns on only when squelch circuits 24 detect the presence of an incoming signal.

Accordingly, the automatic display illumination feature of Karam fails to teach or suggest, inter alia, the claimed “first mode of operation.”- These arguments are not

persuasive: the power indicator illumination is automatically turned on whenever the apparatus is powered on, as claimed and as pointed out in the rejection; because, in this mode, the reason given by the Applicants is that "the backlight of Karam turns on only when squelch circuits 24 detect the presence of an incoming signal", this reason does not mean -the backlight is not automatically turned on whenever the apparatus is powered on. Therefore, Karam teaches the claimed "first mode of operation" as claimed in claims 1 and 8, and as pointed out in the rejection.

Applicants argue on page 7 of the REMARKS that there is no motivation to modify or combine the references. These arguments are not persuasive: the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the reference to Karam is concerned with the status of the apparatus, for instance with the status of the backlight (on or off) of the apparatus; and the Background of the instant application is also concerned with the status of the apparatus, for instance with the status of the lamp of the apparatus. Thus, contrary to the Applicants' arguments, there is motivation to modify or combine the references.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean W. Désir whose telephone number is (571) 272 7344. The examiner can normally be reached on 5/4/9 - First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David L. Ometz can be reached on (571) 272 7593. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JWD
Jul. 9, 06



LIN YE
PRIMARY EXAMINER